REMARKS/ARGUMENTS

Claims 1-11 are pending in the application. Reconsideration and reexamination of the application are hereby respectfully requested.

In the Specification:

Paragraph [0027] is amended to refer to new Figures 6 and 7 where it is describing an embodiment of the invention including a shank of non-circular, and preferably hex shaped. New Figures 6 and 7 are discussed further below. That non-circular / hex shaped embodiment was described in the original disclosure at paragraphs [0010] and [0027].

New paragraphs [0020A] and [0020B] are added to the Brief Description of the Drawings section to describe new Figures 6 and 7.

In the Drawings:

The Examiner has objected to the drawings under 37 CFR 1.83(a) for failing to show the alternative embodiment of "hexagonal cross section" as claimed. Therefore, new Figures 6 and 7 are added. Figures 6 and 7 show an embodiment of the present invention having a hexagonal cross section. Applicant submits that these new figures are not new matter as the tool of hexagonal cross section was described in the original specification at paragraphs [0010] and [0027], and in original dependent claims 4 and 5. Moreover, hexagonal shanks for tools are known in the art.

The Examiner has objected to drawings under 37 CFR 1.83(a) because Figures 3 and 4 fail to show the "forward end (5)" as described in the specification. Therefore, Figures 2 and 3 are amended to add reference number (5) indicating the forward end of forward portion (4).

In the Claims:

Rejection of Claim 1 and 2 under 35 USC §102(b) as anticipated by US 4,491,444

Claim 1, the application's only independent claim, stands rejected under 35 U.S.C. §102 (b), as anticipated by US 4,491,444 to Rumpp et al. The Examiner states that "Rumpp et al. '444 shows a tool . . . where the forward end of the closed groove is located with respect to the rearward end of the tool so that the rear end of the tool is always maintained forward of the forwardmost position of the beatpiece." The Applicant respectfully traverses this rejection.

In support of his understanding of Rumpp '444, the examiner cites to the "gap shown between the tool shank (a) and beatpiece (2) in Fig. 3" of Rumpp. Figure 3, however, depicts the Rumpp tool holder in a particular operat~~ed~~or selected condition. Specifically, it shows the tool holder when sliding sleeve 7 is displaced in the axial direction relative to the retainer member 3. See Rumpp '444 at col. 5 lines 12 – 44. Indeed, it is the stated objective of Rumpp to provide a tool holder capable of permitting percussive drilling with axial movement of the drill bit under one operator selectable condition and to provide rotary drilling without axial movement of the same drill bit under a second operator selectable condition. See Rumpp at col. 1 lines 36 – 55. Thus, Rumpp clearly allows for the rear end of the tool to be contacted by the beatpiece/anvil 2 under some conditions (when percussion/hammering action is desired). See Rumpp Fig. 1. Therefore, it cannot be said that Rumpp '444 teaches a tool having a shank with a closed groove located so that "the rear end of the tool is always maintained forwardly of the forwardmost position of the beatpiece" (emphasis added) as required by Claim 1.

Furthermore, it is not clear to the undersigned that Rumpp's anvil 2 cannot reach the rear end of shank 1, even under the condition depicted in Figure 3. Although Fig. 3 shows the gap noted by the Examiner, it is not clear to the undersigned either from the Figure 3 or the specification that the anvil 2, if driven by mechanisms neither shown nor descried, would not move forward into contact with shank 1. The undersigned found no place in the Rumpp specification where it expressly said that the anvil 2 could not strike the shank 1 in the condition of Fig. 3.

Rather Rumpp consistently describes that condition as one where the shank is deprived of even limited axial movement due to the engagement of stop 7b, locking member 6, and the front shoulder of recess 1a. See Rumpp col. 5 lines 12-28. While it may be desirable that the shank 1 should not be struck by the anvil 2 when the shank is deprived of axial freedom of movement, the undersigned does not see how Rumpp teaches that this is positively prevented. Indeed, Rumpp suggests the necessity of interlocking his tool holder actuating mechanism (sliding sleeve 7) with the hammer's mode change mechanism (not shown or described) to "prevent incorrect handling of the drilling device." Rumpp at col. 2 lines 4-15.

It is irrelevant, however, whether the anvil can strike the shank in Figure 3, since it is clearly demonstrated above that the design of the Rumpp shank 1 does not always maintain its rear end forward of the forwardmost position of the beatpiece/anvil, when installed in the tool holder. This is due to the fundamental difference between the Rumpp invention and the present invention. Rumpp seeks to provide a tool holder that can allow or prevent axial movement of a standard tool shank, depending on user manipulation of certain control mechanisms. The Rumpp tool shank can be used for either hammering or drilling, but Rumpp provides a complex tool holder that can be positioned by the user to suit the intended use. In contrast, the present invention provides a specialized tool shank for use only in rotary drilling/driving functions. The tool of the present invention is unsuitable for any hammering/percussion function because, when it is engaged by the locking bodies of the tool holder, it is always held beyond the reach of the beatpiece, regardless of what the user does with the tool controls. The claimed shank structure of the present invention is specialized for drilling (not hammering) and is expressly intended to avoid reliance on the user to properly select the position of the mode selector (or tool holder), in other words - it is meant to be fool-proof. Rumpp, on the other hand, uses a common SDS or SDS Max type tool shank and expressly relies on the operator to properly select the position of a specialized tool holder. Thus, Rumpp does not "always" maintain the shank "forwardly of the forwardmost position of the beatpiece."

Since the applicant has demonstrated above that Rumpp '444 does not anticipate all the limitations of the subject's independent Claim 1, it is not necessary to separately traverse the section 102(b) rejection of dependent Claim 2. Like wise, the applicant respectfully submits that it is unnecessary to separately traverse the various grounds for rejecting the other independent claims 3 through 11 under 35 U.S.C. §103.

For the foregoing reasons, it is respectfully submitted that this application is in condition for allowance and favorable consideration thereof is requested.

Respectfully submitted

Michael P. Leary

Michael P. Leary
Registration No. 41,144
Attorney for Applicant(s)
March 29, 2005

Michael Leary - TW199
The Black & Decker Corporation
701 East Joppa Road
Towson, Maryland 21286
Telephone: (410) 716-2773

Amendments to the Drawings:

Please cancel/delete the original sheet which includes original Figures 3 and 4.

The attached sheet replaces the original sheet including Figure 3 and 4. In these amended Figures 3 and 4 reference number "5" has been added to indicate "the forward end" of forward portion (4).

Please add the new sheet which includes new Figures 6 and 7.

Attachment: 1 Replacement Sheet of Drawings including FIGS 3 and 4.
1 Annotated Sheet Showing Changes From The Original.
1 New Sheet of Drawings including New FIGS 6 and 7

O I P E
MAR 3 0 2005
JC68
PATENT & TRADEMARK OFFICE

Serial No.: 10/678,659
Title: Drilling Tool For A Rotary Hammer
Inventor: Markus Rompel
Docket No.: P-US-AC 1040
Annotated Sheet

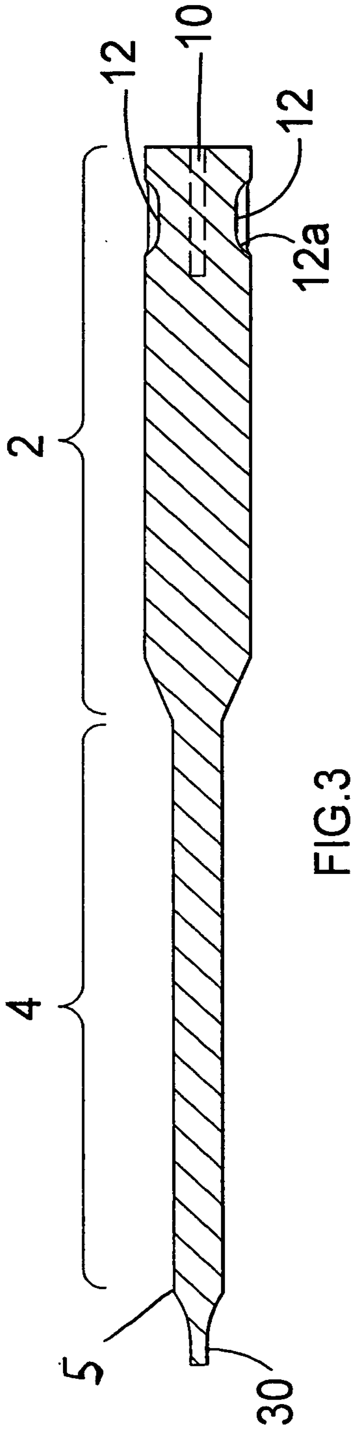

FIG.3

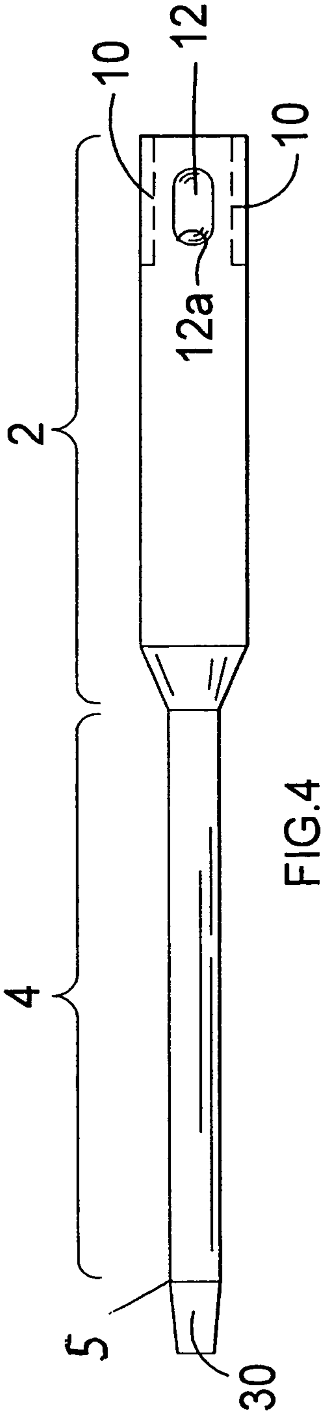

FIG.4